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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1936

No. 21

ESSEX RAZOR BLADE CORPORATION
Petitioner

vs.

GILLETTE SAFETY RAZOR COMPANY
Respondent

REPLY BRIEF FOR PETITIONER

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RESPONDENT'S lengthy brief contains many arguments which we believe to be unsound and citations which we believe to be inapt. Wanting the patience to make a full reply, and being convinced, moreover, that such a reply is unnecessary and would only burden the Court, we content ourselves with the following brief comments:

THE CONFLICT

Respondent, on page 2 of its brief, presumes to instruct the Court as to those matters which it will and will not consider on this petition. Respondent would limit the Court to a consideration of infringement alone because, "the only question on which there has been a conflict of deci-

sions is as to infringement". Respondent is confused, we think, as to the true nature of the conflict, which, in the interest of clarity, we here briefly restate.

The Gaisman patent has been involved in two suits in this country, one in the Second Circuit, one in the Third, and in both suits the accused blade was the same. The Circuit Court of Appeals for the Second Circuit in *Gillette* v. *Hawley* held that respondent had no right under its patent to a monopoly of the accused blade, whereas the Circuit Court of Appeals for the Third Circuit in the instant suit held that it had.

> "Thus as matters stand," we said on page 5 of the petition, "a blade that can be freely made and sold in the Second Circuit is an infringement in the Third, and its manufacture and sale there enjoined.
>
> "The doubt and confusion which must inevitably ensue because of this conflict can be resolved only by this Court".

It is preposterous to suggest that this Court in resolving this conflict is limited in the scope of its inquiry and will consider only the technical question of infringement. In *Bassick Mfg. Co.* v. *R. M. Hollingshead Co.*, and *Rogers* v. *Alemite Corp.*, 56 S. Ct. 787, the conflicts were "with respect to the scope and alleged infringement" of certain claims. Although both courts of appeals whose decisions were in conflict had held the claims valid, the question of validity was, nevertheless, raised by the defendants and considered by this Court (p. 789):

> "Although in the instant cases the validity of the claims is denied, we think they disclose novelty and invention to the extent indicated".

It is difficult to conceive how conflicting decisions on scope and infringement can be considered and the conflict re-

solved without bringing validity into question; for if the claims are invalid a finding of infringement becomes a vain thing. It must be remembered too that the instant case presents no question of concurrent findings by the courts below that the claims in issue involve invention. The District Court held the claims invalid and the Court of Appeals for the Second Circuit in the *Hawley* case did not pass on validity; it merely failed to hold the claims before it *in*valid—which is quite a different thing from a positive finding of validity. Indeed that Court's statement:

> "Moreover, the matter of obtaining proper shaving relation between the parts of the razor and the blade is not new in the present type of Gillette razor.",

is indicative, at least, that a finding of invalidity would have been made had the Court considered such finding necessary.

ANTICIPATION.

As we predicted, respondent has been quick to point out that the razors illustrated (for purpose of argument) on pages 14 and 15 of our main brief are not Hartman and Ballreich razors. Respondent goes further, however, and charges *us* with having invented them. We decline the honor and generously yield it to Gaisman; for certainly those razors are in no essential respect different from the Goodwill razor which is put forward as the embodiment of Gaisman's invention. But respondent has *not* pointed out, because it cannot, in what respects the Gaisman blade, as defined by the claims in suit, differs from either the Hartman or the Ballreich blade. Indeed respondent admits, tacitly at least, that the blades are structurally the same, but asserts, on page 58 of its brief, that this is of no importance:

> "Thus it is unimportant whether the structure of Gaisman's blade physically resembles prior structures. Even if he had used a blade of the precise contour shown in either the Hartman or Ballreich patents, because he used it in a new way to produce a new result he would be entitled to a patent thereon."

This is strange doctrine. Let us examine its implications:

1. The Hartman and Ballreich blades are, by postulate, "of the precise contour" of Gaisman's blade, but do not anticipate because Gaisman "used it [the old blade] in a *new way* to produce a *new result*". By "new way" respondent means that the blade acts as "the active element or key by which the positioning of all three parts of the razor [is] accomplished" (Respondent's brief, p. 5). The "new result" is the reduction in variation in blade exposure, due to cumulative tolerance errors, by 40%, that is from a possible 5/1000 of an inch in the old Gillette razor to 3/1000 in Gaisman's razor—a possible reduction of 2/1000 of an inch or one-half the breadth of a hair! (Respondent's brief, p. 11).

2. If the Hartman and Ballreich blades do not anticipate because not used in Gaisman's "new way" to produce his "new result", despite their having Gaisman's "precise contour", then it follows that *no* blade infringes that is not used in the "new way" to produce the "new result". That which does not anticipate if earlier does not infringe if later.

3. Respondent concedes that petitioner is "free, so far as the patent in suit is concerned, to manufacture and sell blades which will fit every one of the many millions of Gillette type razors which the respondent and others have produced, * * *" which do not embody Gaisman's invention (Respondent's brief, p. 44). By respondent's

leave, therefore, let us place one of petitioner's blades in one of these millions of razors which do not embody Gaisman's invention—in an old three-post razor, for example. *That* blade, obviously, is not used in Gaisman's "new way" and does not, of course, "produce a new result". Ergo, as we have proved (2), it does not infringe.

4. Thus are we led, willy-nilly, to the surprising conclusion that petitioner's blade in a Goodwill razor is an infringing blade, while *the same blade* in any other razor —or wrapped in cellophane for that matter—is not; that we cannot possibly know by a simple inspection of the blade itself into which category it falls. (It is conceivable—although we express no opinion on the point—that the combination of petitioner's blade in a Goodwill razor might infringe the combination claims of the patent, while the combination of the same blade in another razor might not. But we are concerned here with claims to the naked blade only.)

To round out the *reductio ad absurdum,* let us consider for a moment the case of the man who has on his bath-room shelf a Goodwill razor, an old style Gillette razor and a package of petitioner's blades. About to shave, he deftly removes a blade from the package and, holding it lightly between thumb and forefinger, contemplates his two razors, cogitating a choice. Which shall it be? Meanwhile, what of the blade so lightly poised? Is it an infringing blade, notched and slotted as it undeniably is? Or is it not? We do not know, nor shall we know until the choice of razors has been made. . . . All of which strikes us as not a little silly. And it certainly ruins respondent's proof of infringement.

Gaisman may have valid claims to the combination of his razor *and* blade by which the "new way" of use is made

possible; but valid claims to the old, bare blade itself? *Never.* There is nothing better settled in our patent law than this: that only *new* things are patentable; and not one of the authorities cited so profusely by respondent on pages 54 through 63 of its brief holds to the contrary; nor would be valid if it did. One of these, *Potts* v. *Creager,* 155 U. S. 597, is perhaps the leading case on the question of new use. There this Court, after reviewing the authorities, said (608):

> "As a result of the authorities upon this subject, it may be said that, if the new use be so nearly analogous to the former one, that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, it is only a case of double use, but if the relations between them be remote, and especially if the use of the old device produce a new result, it *may* at least involve an exercise of the inventive faculty. Much, however, must still depend upon the nature of the changes required to adapt the device to its new use." (Italics by the Court.)

"*Much, however, must still depend upon the nature of the changes required to adapt the device to its new use.*" But here, by postulate, *no* changes of *any* nature are required of the Hartman and Ballreich blades to adapt them to Gaisman's "new use". And there must be *some* change to support a patent. On this point the statute is clear. In *H. K. Regar & Sons, Inc.,* v. *Scott & Williams, Inc.,* 63 F. (2d) 229, quoted on page 59 of respondent's brief, the Court of Appeals for the Second Circuit has lately stated the law clearly and well. There as here, the attempt was made to sustain a patent for an old thing. The Court said:

> "Cases like * * * Potts v. Creager, 155 U. S. 597, 608, * * * are to be distinguished. When old devices are changed at all, the change may be dictated by a new

> conception, which it took originality to conceive. Strictly, the old device is not then put to a new use; the new use begets a new device. In such cases it requires but little physical change to make an invention. * * * But a new use of an old thing or an old process, quite unchanged, can under no circumstances be patentable; not because it may not take as much inventiveness to discover it, as though some trivial change were necessary, but because the statute allows patents only for a new 'art, machine, manufacture or composition of matter' (section 31, title 35, U. S. Code [35 U. S. C. A., §31]). The test is objective; mere discovery will not do."

Gaisman's mere discovery that the old blades of the Hartman and Ballreich patents might be used in a "new way to produce a new result" (assuming the novelty of the way of use and the result) is not enough. He cannot patent an "old thing . . . quite unchanged".

If now respondent cries: "Hold, not so fast; perhaps we *were* a bit hasty. Gaisman's blade does not, after all, have the *precise* contour of a Hartman or Ballreich blade. It is thus not an "old thing . . . *quite* unchanged": observe Gaisman's diamond-shaped central opening; observe his end notches",—if respondent says that, then we invite it to examine petitioner's blade once more and explain how such a blade infringes. Respondent may not make of its patent that amazingly selective firing-piece contrived "to hit it if it is a deer and miss if it is a cow"; a magic weapon indeed, but one encountered, happily, only in fairy tales. As the Circuit Court of Appeals for the Sixth Circuit said in *Wm. B. Scaife & Sons Co.* v. *Falls City Woolen Mills,* 209 Fed. 210, 213:

> "Obviously, the * * * broader view of the claim is necessary to make out infringement, and so the proof of anticipation must be considered from the same point of view, * * *."

THE "NEW PRINCIPLE".

> *"Prior to Gaisman no one ever produced a blade embodying Gaisman's new principle which caused the blade to act as a key to position all the parts of a safety razor."*

This declaration appears on page 44 of respondent's brief. Being fully italicized, it must be important. What then *is* this "new principle" embodied in Gaisman's blade "which cause[s] the blade to act as a key"? For the life of us we don't know. The only things *we* can see embodied in the Gaisman blade are the diamond-shaped central hole and the end notches. Do these things constitute a new principle? We wish that respondent had laid out, side by side, a Hartman blade, a Ballreich blade, a Gaisman blade, and an Essex (petitioner's) blade and had explained what "new principle" is embodied in the latter two not equally well embodied in the former.

This talk about principles being embodied in safety razor blades to cause them to act in certain ways is just so much nonsense. No matter what principles Gaisman's blade may embody, it cannot possibly "act as a key to position all the parts of a safety razor" until a very special razor comes along with all its parts designed for positioning. Without that razor, Gaisman's blade is just as impotent as the presumably unprincipled Hartman and Ballreich blades. *With* that razor, Hartman and Ballreich, for all their lack of principle, would coöperate quite as effectively as Gaisman, the embodiment of a principle—as we have demonstrated on pages 14 and 15 of our main brief. Which only goes to prove that although principle as a motivating force among men may be a highly desirable and effective thing, among razor blades it is altogether useless.

INFRINGEMENT.

A section of respondent's brief, beginning on page 25, is headed "Decreasing or impairing efficiency does not avoid infringement". As a general proposition this may be conceded. But where, as here, the whole reputed merit of the invention is in *increased* efficiency, those who are content with the old inefficiency, or worse, can hardly be accused of appropriating respondent's property. As a matter of fact the slot and notches in petitioner's blade are put there, quite evidently, not to make Gaisman's snug fit with the Goodwill lugs, and thereby reduce variation in blade exposure by 2/1000 of an inch (which they do not), but simply to escape those troublesome and wholly unwelcome excrescences on an otherwise excellent razor.

It is difficult, we are free to confess, to consider infringement in a case where the claims are so clearly invalid. But if they *are* valid, as respondent insists at such tiresome length, fortified by such a formidable array of authorities, it can only be because of things not present in petitioner's blade, either actually or potentially.

PATENTS DO EXPIRE.

In conclusion we wish to thank respondent for its generous reminder that the Gaisman patent will expire in eight years and that thereafter petitioner may make notched and slotted blades without let or hindrance soever. We had not supposed respondent aware of this latent defect in all patent grants—this blight of mortality—although ourselves quite sensible of it. But why, we wonder, must we wait eight long years for Gaisman's demise when the Hartman and Ballreich patents have already expired—Hartman and Ballreich, both of which disclose notched and slotted blades of Gaisman's "precise contour"?

Respectfully submitted,

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October, 1936.